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OFFICE OF PETITIONS

In re Application of Little Jr. Application No. 09/652,648 Filed: August 21, 2000 Attorney Docket No. TAL/0002

: DECISION GRANTING PETITION IN PART AND HOLDING PETITION IN ABEYANCE PART

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 1.705" timely ¹filed June 30, 2006 requesting that the Office adjust the calculation at the time of the notice of allowance from a determination of 0 days to a determination of 902 days.

The application is granted-in-part as it relates to all PTA issues other than 37 CFR 1.702(b). The petition related to 37 CFR 1.702(b) will be held in abeyance until after the actual patent issue date. The determination of zero (0) days remains. However, the amount of USPTO delay is 808 days and the amount of applicant delay remains 855 days.

Applicants assert that the proper amount of calculation is 1031 days under 37 CFR 1.704(b), 118 days under 37 CFR 1.702(a)(1), 35 days under 37 CFR 1.702(a)(2). Applicants further asset that the amount of applicant delay is 189 days and 62 days.

Applicants arguments are persuasive to the extent herein indicated. The Office notes that there was a delay under 37 CFR 1.702(a)(1), but the delay amounted to 119 days not 118 days asserted by applicant. Moreover, the Office delayed by a period of 205 days under 37 CFR 1.702(a)(2) for filing a reply to applicant response of 8/6/2004 on June 29, 2005.² In addition, the USPTO mailed the notice of allowance on May 17, 2006, 195 reduction under 37 CFR 1.702(a)(2). In addition, the USPTO failed to assess a delay of 289 days for the failure to reply to applicants amendment until 3/5/2004. The additional PTA grant was also under 37 CFR 1.702(a)(2). Applicant delays of 292 days and 563 days are proper reduction under 37 CFR 1.704(c)(7).

¹Issue fee paid on June 30, 2006.

²The delay began on 12/7/04 and ended on June 29, 2005, date of mailing of reconstruction notice.

Accordingly, at the time of the mailing of the notice of allowance the amount of delay USPTO delay is 808 days. The amount of applicant delay is 855. Accordingly, the overall amount of PTA remains zero (0) days at the time of the mailing of the notice of allowance.

In addition, the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, under 37 CFR 1.702(b) as well as failing to issue the application within four months of the payment of the issue fee a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). Knowledge of the issue date is also necessary to determine whether or not the USPTO issued the application within four months of the payment of the issue fee and all other requirements being satisfied. See 37 CFR 1.702(a)(4).

Patentees are given **TWO** (2) **MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years and whether the Office issued the application within four months of the payment of the issue fee. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).

The office also notes that at the time of the mailing of allowance, the amount of PTA is four hundred and eleven days (411) days with five hundred and fifty-nine (559) days of administrative delay pursuant to 37 CFR 1.702(a)(1). Applicant delayed twenty-six (26) days pursuant to 37 CFR 1.704(c)(8) and one hundred and twenty-two (122) days of applicant delay under 37 CFR 1.704(b).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any Office delays in issuance of the patent more than four months past the payment of the issue fee and more than three years after the filing date will be provided for in the issuance notification letter mailed prior to the issuance of the patent.

Telephone inquiries specific to this matter should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7757.

Kery Fries

Senior Legal Advisor

Office of Patent Legal Administration

Office of Deputy Commissioner

for Patent Examination Policy

cc: Pair calculation

Day: Tuesday Date: 2/20/2007

Time: 15:06:16

PALM INTRANET

PTA Calculations for Application: <u>09/652648</u>							
Application Filing Date:	08/31/2000	PTO Delay (PTO):	519				
Issue Date of Patent:		Three Years:	0				
Pre-Issue Petitions:	0	Applicant Delay (APPL):	855				
Post-Issue Petitions:	0	Total PTA (days):	0				
PTO Delay Adjustment:	289						

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23	- 1183 4 / 115 / 76 16 1/11	MAIL NOTICE OF INFORMAL OR NON- RESPONSIVE AMENDMENT			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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